



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/032,535

01/02/2002

John C. Shaw

054253-5001

5955

24271 7590 09/22/2010
JOHN ALEXANDER GALBREATH
2516 CHESTNUT WOODS CT
REISTERSTOWN, MD 21136

EXAMINER

OYEBISI, OJO O

ART UNIT

PAPER NUMBER

3695

MAIL DATE

DELIVERY MODE

09/22/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/032,535	Applicant(s) SHAW ET AL.	
	Examiner OJO O. OYEBISI	Art Unit 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-163 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-163 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 52, 62, 105, 115, 148 and 158 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant recites the limitation "a data security component for **preventing knowledge** of any given prospective transaction entry." The examiner searched the length and breadth of the applicant's specification, but failed to find a single paragraph where support for this limitation is recited.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3695

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-163 are rejected under 35 U.S.C. 103(a) as being unpatentable over "LEXSEE 1991 SEC NO-ACT. LEXIS 1112, October 1, 1991" hereinafter SEC) in view of Gutterman et al (US PAT: 5297031).

Re Claim 1: SEC discloses a method for anonymously and confidentially determining counterparties to a transaction and notifying an authorized representative of the counterparties to contact the counterparties in order to consummate a transaction comprising the steps of:

- Receiving indications of interest from potential transferees and potential transferors into a central processing system (Page 2, Part B) each indication of interest involving a transfer of a specific item; anonymously comparing indications of interest received from potential transferees with indications of interest received from potential transferors within the central processing system to determine whether a match has occurred (Page 1, First full paragraph; "permits participants to enter anonymously limit orders to buy or sell those securities and to (1) match that buy and sell interest with countervailing interest on the other side of the market; or (2) enter into a negotiation process that may ultimately produce an executed trade.");

Art Unit: 3695

- determining counterparties to a transaction based on said determination of whether a match has occurred (Page 1 first full paragraph match that buy and sell interest with countervailing interest on the other side of the market);
- notifying the authorized representative of the counterparties that a match has occurred between the counterparties (Page 3, first full paragraph 'LIMITrader dials the counterparty's trading desk and notifies the counterparty that the orders have matched');
- Providing,contacting means to the authorized representative to allow the authorized representative to contact the counterparties so that a transaction can be consummated between the counterparties, and consummating the transaction between the counterparties through direct consummation by the authorized representative of the counterparties (Page 3; under [8]; entire paragraph; "LIMITrader will dial up the participantthat entered the existing order...The first participant so notified that responds to the incoming order may begin an automated negotiation process."),

SEC does not explicitly disclose wherein the authorized representative notifies each counterparty of the match at the same time, and no counterparty receives notice of the match before another counterparty. However, LIMITrader, as taught by SEC, discloses calling at least one order party of having a transaction indication which is matched (see Page 3, first full paragraph "LIMITrader dials the counterparty's trading desk and notifies the counterparty that the orders have matched"). That is, LIMITrader will dial-up the participant that entered an existing order so that it can begin an automated negotiation

Art Unit: 3695

process with an incoming order (see pg 3). Thus, it is predictable to send another notification to the just-submitted ordering party since the two parties are ultimately going to be placed in negotiation, LIMITrader discloses an option of anonymity between prospective counterparties, and LIMITrader already teaches the notification of one of the two parties who will ultimately need to contact each other in order to negotiate. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739 (2007). Further, the effect of the LIMITrader system is to ultimately put only one party in touch with only one counter party. Moreover, communication between counterparties at the inception of dealings would be a predictable way to further and promote the object of LIMITrader which is to "match that buy or sell interest with countervailing interest in the same security on the other side of the market, or (ii) enter into a negotiation process that may ultimately produce an executed trade." . "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one. If a person of ordinary skill in the art can implement a predictable variation, § 103 likely bars its patentability." *Id.* at 1740.

SEC further does not explicitly disclose wherein the indications of interest are received from an order management system integrated with the central processing system. However, Gutterman discloses an order management system (see the abstract, see figs.2a-2d, also see the summary of the invention). Thus, It would have been obvious to a person of ordinary skill in the art to combine the OMS teachings of Gutterman with the

Art Unit: 3695

disclosure of the SEC to allow users to manage their decks and to improve the accuracy of communications between the trading floor and the customers.

Re Claims 2-4: SEC discloses the claimed method supra and further discloses wherein the received indications of interest involves the transfer of an equity security, a debt security and a derivative security (Page 1, first paragraph)

Re Claims 5-7, 9-11, 13-17: SEC discloses the claimed method supra and further discloses the use of limit orders and direct matches (Page 2, Part B "A participant wishing to trade on the System may enter a limit order, which may be either a firm position or an "indication.").

Re Claim 8: SEC discloses the claimed method supra but does not explicitly disclose the step wherein at least one of the indications of interest includes ancillary information not used in determining whether a match has occurred in said comparing step but which is transmitted to a matched counterparty during said consummating the transaction step to assist in consummation by the contraparties. However as noted earlier, SEC discloses the step of placing the parties in contact with each other either by phone or electronically. Therefore it is inherent that the parties had provided either telephone numbers or email addresses, which were not relevant to the matching process. Without providing this information it would not be possible for the host to arrange communication.

Re Claim 12: SEC discloses the claimed method supra and further discloses wherein said providing step also includes providing contacting means directly to the contraparties (Page 3; under [8]; entire paragraph; "LIMITrader will dial up the

Art Unit: 3695

participant that entered the existing order...The first participant so notified that responds to the incoming order may begin an automated negotiation process.")

Re Claim 18: SEC discloses a method for anonymously and confidentially determining counterparties to a transaction and introducing authorized representatives of each respective counterparty to each other in order for the authorized representatives to consummate a transaction, comprising the steps of:

- Receiving indications of interest from potential transferees and potential transferors into a central processing system (Page 2, Part B) wherein the indications of interest are received from an order management system (i.e. keystations; See abstract and Fig 8 "KS A and KS B") integrated with the central processing system each indication of interest involving a transfer of a specific item; anonymously comparing indications of interest received from potential transferees with indications of interest received from potential transferors within the central processing system to determine whether a match has occurred (Page 1, First full paragraph; "permits participants to enter anonymously limit orders to buy or sell those securities and to (1) match that buy and sell interest with countervailing interest on the other side of the market; or (2) enter into a negotiation process that may ultimately produce an executed trade.");
- Determining counterparties to a transaction based on said determination of whether a match has occurred (Page 1 first full paragraph match that buy and sell interest with countervailing interest on the other side of the market);
- Notifying the counterparties and their respective authorized representatives that a

Art Unit: 3695

match has occurred between the counterparties; (Page 3, first full paragraph 'LIMITrader dials the counterparty's trading desk and notifies the counterparty that the orders have matched");

- Providing contacting means to the authorized representative to allow the authorized representative to contact the counterparties so that a transaction between the counterparties through direct consummation by the authorized representative and the counterparties (Page 3; under [8]; entire paragraph; "LIMITrader will dial up the participant that entered the existing order...The first participant so notified that responds to the incoming order may begin an automated negotiation process."). SEC does not explicitly disclose wherein the authorized representative notifies each counterparty of the match at the same time, and no counterparty receives notice of the match before another counterparty. However, LIMITrader, as taught by SEC, discloses calling at least one order party of having a transaction indication which is matched (see Page 3, first full paragraph "LIMITrader dials the counterparty's trading desk and notifies the counterparty that the orders have matched"). That is, LIMITrader will dial-up the participant that entered an existing order so that it can begin an automated negotiation process with an incoming order (see pg 3). Thus, it is predictable to send another notification to the just-submitted ordering party since the two parties are ultimately going to be placed in negotiation, LIMITrader discloses an option of anonymity between prospective counterparties, and LIMITrader already teaches the notification of one of the two parties who will ultimately need to contact each other in order to negotiate. The combination of familiar elements according to known methods is likely to be obvious

Art Unit: 3695

when it does no more than yield predictable results." KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1739 (2007). Further, the effect of the LIMITrader system is to ultimately put only one party in touch with only one counter party. Moreover, communication between counterparties at the inception of dealings would be a predictable way to further and promote the object of LIMITrader which is to "match that buy or sell interest with countervailing interest in the same security on the other side of the market, or (ii) enter into a negotiation process that may ultimately produce an executed trade." . "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one. If a person of ordinary skill in the art can implement a predictable variation, § 103 likely bars its patentability." Id. at 1740. SEC further does not explicitly disclose wherein the indications of interest are received from an order management system integrated with the central processing system. However, Gutterman discloses an order management system (see the abstract, see figs.2a-2d, also see the summary of the invention). Thus, It would have been obvious to a person of ordinary skill in the art to combine the OMS teachings of Gutterman with the disclosure of the SEC to allow users to manage their decks and to improve the accuracy of communications between the trading floor and the customers.

Re Claims 19-21: SEC discloses the claimed method supra and further discloses wherein the received indications of interest involves the transfer of an equity security, a debt security and a derivative security (Page 1, first paragraph)

Re Claims 22-24, 26-28, 30-34: SEC discloses the claimed method supra and further

Art Unit: 3695

discloses the use of limit orders and direct matches (Page 2, Part B "A participant wishing to trade on the System may enter a limit order, which may be either a firm position or an "indication.").

Re Claim 25: SEC discloses the claimed method supra but does not explicitly disclose the step wherein at least one of the indications of interest includes ancillary information not used in determining whether a match has occurred in said comparing step but which is transmitted to a matched counterparty during said consummating the transaction step to assist in consummation by the contraparties. However as noted earlier, SEC discloses the step of placing the parties in contact with each other either by phone or electronically. Therefore it is inherent that the parties had provided either telephone numbers or email addresses, which were not relevant to the matching process. Without providing this information it would not be possible for the host to arrange communication.

Re Claim 29: SEC discloses the claimed method supra and further discloses wherein said providing step also includes providing contacting means directly to the contraparties (Page 3; under [8]; entire paragraph; "LIMITrader will dial up the participant that entered the existing order...The first participant so notified that responds to the incoming order may begin an automated negotiation process.")

Re Claim 35: SEC discloses a method for anonymously and confidentially determining contraparties to a transaction and notifying an authorized representative of the contraparties to contact the contraparties in order to consummate a transaction comprising the steps of:

Art Unit: 3695

- Receiving indications of interest from potential transferees and potential transferors into a central processing system (Page 2, Part B) each indication of interest involving a transfer of a specific item; anonymously comparing indications of interest received from potential transferees with indications of interest received from potential transferors within the central processing system to determine whether a match has occurred (Page 1, First full paragraph; "permits participants to enter anonymously limit orders to buy or sell those securities and to (1) match that buy and sell interest with countervailing interest on the other side of the market; or (2) enter into a negotiation process that may ultimately produce an executed trade.");
- determining counterparties to a transaction based on said determination of whether a match has occurred (Page 1 first full paragraph match that buy and sell interest with
- notifying the authorized representative of the counterparties that a match has occurred between the counterparties (Page 3, first full paragraph 'LIMITrader dials the counterparty's trading desk and notifies the counterparty that the orders have matched");
- Providing contacting means to the authorized representative to allow the authorized representative to contact the counterparties so that a transaction between the counterparties through direct consummation by the authorized representative and the counterparties (Page 3; under ['8]; entire paragraph; "LIMITrader will dial up the participantthat entered the existing order...The first participant so notified that responds to the incoming order may begin an automated negotiation process."). SEC does not explicitly disclose wherein the authorized representative notifies each counterparty of the

Art Unit: 3695

match at the same time, and no contraparty receives notice of the match before another contraparty. However, LIMITrader, as taught by SEC, discloses calling at least one order party of having a transaction indication which is matched (see Page 3, first full paragraph "LIMITrader dials the counterparty's trading desk and notifies the counterparty that the orders have matched"). That is, LIMITrader will dial-up the participant that entered an existing order so that it can begin an automated negotiation process with an incoming order (see pg 3). Thus, it is predictable to send another notification to the just-submitted ordering party since the two parties are ultimately going to be placed in negotiation, LIMITrader discloses an option of anonymity between prospective counterparties, and LIMITrader already teaches the notification of one of the two parties who will ultimately need to contact each other in order to negotiate. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739 (2007). Further, the effect of the LIMITrader system is to ultimately put only one party in touch with only one counter party. Moreover, communication between counterparties at the inception of dealings would be a predictable way to further and promote the object of LIMITrader which is to "match that buy or sell interest with countervailing interest in the same security on the other side of the market, or (ii) enter into a negotiation process that may ultimately produce an executed trade." . "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one. If a person of ordinary skill in the art can implement a predictable variation, § 103 likely bars its

Art Unit: 3695

patentability." Id. at 1740. SEC further does not explicitly disclose wherein the indications of interest are received from an order management system integrated with the central processing system. However, Gutterman discloses an order management system (see the abstract, see figs.2a-2d, also see the summary of the invention). Thus, It would have been obvious to a person of ordinary skill in the art to combine the OMS teachings of Gutterman with the disclosure of the SEC to allow users to manage their decks and to improve the accuracy of communications between the trading floor and the customers.

Re Claims 36-38: SEC discloses the claimed method supra and further discloses wherein the received indications of interest involves the transfer of an equity security, a debt security and a derivative security (Page 1, first paragraph)

Re Claims 39-41, 43-45, 46-50: SEC discloses the claimed method supra and further discloses the use of limit orders and direct matches (Page 2, Part B "A participant wishing to trade on the System may enter a limit order, which may be either a firm position or an "indication.").

Re Claim 42: SEC discloses the claimed method supra but does not explicitly disclose the step wherein at least one of the indications of interest includes ancillary information not used in determining whether a match has occurred in said comparing step but which is transmitted to a matched counterparty during said consummating the transaction step to assist in consummation by the contraparties. However as noted earlier, SEC discloses the step of placing the parties in contact with each other either by phone or electronically. Therefore it is inherent that the parties had provided either telephone

Art Unit: 3695

numbers or email addresses, which were not relevant to the matching process. Without providing this information it would not be possible for the host to arrange communication.

Re Claim 51: Further information management system claims would have been obvious in order to perform the previously rejected method claims 1, 18 and 35 and are therefore rejected using the same art and rationale.

Re Claims 68-77: Further system claims would have been obvious in order to implement previously rejected method claims 2-8 and 12-14 respectively, and are therefore rejected using the same art and rationale.

Re Claims 78: Further method claim would have been obvious from the previously rejected system claim 51 and is therefore rejected using the same art and rationale

Re Claims 79-93: Further method claims contain the same limitations as previously rejected method claims 2-11 and 13-17 respectively and are therefore rejected using the same art and rationale.

Re Claim 94: As shown in the previous rejection of claim 51, SEC discloses the claimed information management system, and SEC further discloses wherein these indications of interest are non-firm (Column 4, lines 38-43)

Re Claim 95-104: Further system claims contain the same limitations as previously rejected system claims 68-77 respectively and are therefore rejected using the same art and rationale.

Re Claim 121: As shown in the previous rejection of claim 78, SEC discloses the claimed method, and SEC further discloses wherein the process receives prospective

Art Unit: 3695

transaction entries

Re Claims 122-136: Further method claims contain the same limitations as previously rejected method claims 2-11 and 13-17 respectively and are therefore rejected using the same art and rationale.

Re Claim 137: As shown in the previous rejection of claim 51, SEC discloses the information management system, and SEC further discloses wherein the process receives prospective transaction entries

Re Claims 138-147: Further information management system claims contain the same limitations as previously rejected system claims 68-77 respectively and are therefore rejected using the same art and rationale.

Re Claim 52: SEC discloses a secure system for the trading of transferable commodities, including:

- A network, including a secure station and a plurality of remote user locations having respective user identities and communicatively linked to the secure station for data transmission between the secure station and the user locations (Page 2, 'Description of the System; permitting those users to enter, on an anonymous basis, limit orders to buy or sell those securities.);
- a memory at the secure station for storing user data and for storing transaction data in the form of multiple prospective transaction entries received from the user locations, each of the entries including a transferable item indication and a transaction side indication identifying one of two opposing transaction sides (Bottom Page 2-Page 2 "a participant may access information about orders currently in the System, enter or modify

Art Unit: 3695

an order, or access research information. The order book that a participant sees will show all non-blind bids and/or offers in the System.);

- a search component operatively coupled to the memory, said search component performing a comparison of the stored entries with respect to the transferable item indications and the transaction side indications and, based on said comparison, to select sets of two or more of the stored entries as matching entries having the same transferable item indication and together including transaction side indications identifying the opposing transaction sides (Page 3; The ranges of price and size parameters entered by a participant willing to negotiate an order permit the System to identify orders that may ultimately result in a match.),
- a message sending component operatively coupled to the search component and to the memory and, in response to the selection of each said set of matching entries, generating a prospective transaction message including the transaction indication corresponding to each of the matching entries and further providing the prospective transaction message to the user locations associated with the corresponding user identities (Page 3, LIMITrader dials two calls at a time beginning with the longest standing orders first)
- A data security component for restricting access to any given prospective transaction entry, even if unmatched, stored in the memory to (i) the user identity corresponding to the given entry and (ii) the user identities corresponding to the other entries in any of said sets of entries that includes the given entry (Page 9; "The Company has in place security procedures reasonably designed to (i) prevent unauthorized access to

Art Unit: 3695

LIMITrader, both by employees of the Company or the clearing broker, by participants in the system and by persons who are not affiliated with the Company, the clearing broker or the system, and (ii) to safeguard the system to protect against threats to the proper functioning of the system.".). SEC does not explicitly disclose wherein the authorized representative notifies each contraparty of the match at the same time, and no contraparty receives notice of the match before another contraparty. However, LIMITrader, as taught by SEC, discloses calling at least one order party of having a transaction indication which is matched (see Page 3, first full paragraph "LIMITrader dials the counterparty's trading desk and notifies the counterparty that the orders have matched"). That is, LIMITrader will dial-up the participant that entered an existing order so that it can begin an automated negotiation process with an incoming order (see pg 3). Thus, it is predictable to send another notification to the just-submitted ordering party since the two parties are ultimately going to be placed in negotiation, LIMITrader discloses an option of anonymity between prospective counterparties, and LIMITrader already teaches the notification of one of the two parties who will ultimately need to contact each other in order to negotiate. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1739 (2007). Further, the effect of the LIMITrader system is to ultimately put only one party in touch with only one counter party. Moreover, communication between counterparties at the inception of dealings would be a predictable way to further and promote the object of LIMITrader which is to "match that buy or sell interest with countervailing interest in the same

Art Unit: 3695

security on the other side of the market, or (ii) enter into a negotiation process that may ultimately produce an executed trade." . "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one. If a person of ordinary skill in the art can implement a predictable variation, § 103 likely bars its patentability." Id. at 1740.

SEC further does not explicitly disclose

- Facilitating an interaction among users associated with the user locations to complete a transaction involving the transferable item, wherein the users interact with each other to complete the transaction. However, LIMITrader does disclose that participants are notified of a potential transaction so that they may begin potential negotiation. It would have been obvious to a person of ordinary skill in the art to include the step of further facilitating these negotiations so that the system has a complete record of the transaction and so that the integrity of the transaction in its entirety is protected within the system

Re Claim 53: SEC further discloses wherein said message sending component provides the prospective transaction message substantially simultaneously to the user locations associated with said corresponding user identities (Page 3, paragraph under [•8]).

Re Claim 54: SEC further discloses a menu for enabling users to select transferable item indications corresponding to different types of transferable items (Page 1 "permits participants to buy or sell those securities")

Re Claim 55: SEC further discloses wherein said menu is stored in memory (Bottom

Art Unit: 3695

page 2; "a participant may access information about orders currently in the System)

Re Claim 56: SEC further discloses wherein the data security component includes a plurality of user pages maintained at the secure station each of the user pages having associated with and accessible only by one of the users (Page 9, 5th paragraph).

Re Claim 57: SEC further discloses wherein each of the prospective transaction entries includes a further indication selected from a group of further indications consisting of: an amount indication designating an amount of the transferable item corresponding to the transferable item indication; a price indication designating an acceptable price or an acceptable price range and a time limit indication (Page 2 "Participants may further limit a position...such as limitation of types of counterparties acceptable, minimum trade size, timed release.").

Re Claim 58: SEC further discloses an apportionment component, responsive to the selection of a set of matching entries that includes at least two entries having the same transaction side, for apportioning the designated amount of the transferable item among the user identities corresponding to the given transaction side (Page 3, "ranges of price and size parameters." Also "LIMITrader will execute a partial fill.")

Re Claim 59: SEC further discloses wherein the memory includes an active segment for storing prospective transaction entries with none of said further indications and for storing entries including further indications that are satisfied; and a suspended segment for storing prospective transaction entries including a further indication which is not satisfied, wherein the secure station further includes an entry monitoring component operatively associated with the active and suspended segments, for repeatedly

Art Unit: 3695

monitoring the entries that include a further indication, to determine whether that further indication is satisfied, and wherein said search component performs said comparison only upon the entries stored in the active segment (Bottom Page 2 - Page 3; "information about orders currently in the System;" "LIMITrader automatically executes a trade if such order matches a firm order already existing in LIMITrader.")

Re Claim 60: SEC further discloses wherein the memory further includes a pending segment for storing prospective transaction entries designated as pending by the corresponding users and a means for shifting an entry from the pending segment to the active segment responsive to a signal from the corresponding user location activating the entry (Bottom Page 2; "Once logged in, a participant may access information about orders currently in the System, enter or modify an order or access research information.").

Re Claim 61: SEC further discloses a status designation component enabling each user to alternatively designate a prospective transaction entry as active or pending; wherein the memory includes an active memory segment for storing entries designated as active, and an inactive segment for storing entries designated as pending and means for transferring from one of said segments to the other in response to a change in designation (Bottom of Page 2-Top page 3).

Re Claim 62: Further process claim would have been obvious from the previously rejected system claim 52 and is therefore rejected using the same art and rationale.

Re Claim 63: SEC further discloses wherein said message sending component provides the prospective transaction message substantially simultaneously to the user

Art Unit: 3695

locations associated with said corresponding user identities (Page 3, paragraph under ['8]).

Re Claim 64: SEC further discloses wherein prior to receiving the prospective transaction entries from a given user, authorizing the given user based on the give user's meeting of predetermined qualification requirements (Page 2 Part A. "Each applicant for participation must be approved by the Company.")

Re Claim 65: SEC further discloses wherein said restricting access includes maintaining at the secure location a plurality of user pages, each user page personalized to an accessible only by an associated one of the user locations (Page 3 "a participant may view its own bids and/or offers"; Page 10).

Re Claim 66: SEC further discloses wherein each of the prospective transaction entries further optionally includes a condition, and the process further includes: identifying the prospective transaction entries that include a condition and monitoring each of the entries so identified to determine whether the associated condition is satisfied (Page 2, Part B, "Participants may further limit a position.").

Re Claim 67: SEC further discloses wherein at least a portion of the prospective transaction entries include an amount indication associated with the transferable item indication and the process further includes: responsive to the selection of a set that includes at least two entries with the same transaction side indication, apportioning the transferable item among users indicating said same side transaction (Page 3 "If an incoming firm order matches but does not fill an existing firm order, LIMITrader will execute a partial fill.")

Art Unit: 3695

Re Claim 105: As shown in the previous rejection of claim 52, SEC discloses the claimed limitations and further discloses wherein these indications of interest are non-firm (Page 2, Part B).

Re Claims 106-114: Further secure system claims contain the same limitations as previously rejected system claims 53-61 and are therefore rejected using the same art and rationale.

Re Claims 115: As shown in the previous rejection of claim 62, SEC discloses the claimed limitations and further discloses further discloses wherein these indications of interest are non-firm (Page 2, Part B, Page 10, first paragraph)).

Re Claims 116-120: Further process claims contain the same limitations as previously rejected process claims 63-67 and are therefore rejected using the same art and rationale.

Re Claims 148: As shown in the previous rejection of claim 52, SEC discloses the claimed limitation and further discloses wherein the entries include a transferable item element and a transaction side element (Bottom Page 2-Page 2 "a participant may access information about orders currently in the System, enter or modify an order, or access research information. The order book that a participant sees will show all non-blind bids and/or offers in the System.)

Re Claims 149-157: Further system claims contain the same limitations as previously rejected system claims 53-61 and are therefore rejected using the same art and rationale.

Re Claim 158: As shown in the previous rejection of claim 62, SEC discloses the

Art Unit: 3695

claimed limitations and further discloses wherein the entries include a transferable item element and a transaction side element (Bottom Page 2-Page 2 "a participant may access information about orders currently in the System, enter or modify an order, or access research information. The order book that a participant sees will show all non-blind bids and/or offers in the System.)

Re Claims 159-163: Further process claims contain the same limitations as previously rejected process claims 63-67 and are therefore rejected using the same art and rationale.

Response to Arguments

Applicant's arguments filed on 07/30/2010 have been fully considered but they are not persuasive. The applicant argues in substance that SEC does not explicitly disclose wherein the authorized representative notifies each contraparty of the match at the same time, and no contraparty receives notice of the match before another contraparty. However, LIMITrader, as taught by SEC, discloses calling at least one order party of having a transaction indication which is matched (see Page 3, first full paragraph "LIMITrader dials the counterparty's trading desk and notifies the counterparty that the orders have matched"). That is, LIMITrader will dial-up the participant that entered an existing order so that it can begin an automated negotiation process with an incoming order (see pg 3). Thus, it is predictable to send another notification to the just-submitted ordering party since the two parties are ultimately going to be placed in negotiation, LIMITrader discloses an option of anonymity between prospective counterparties, and LIMITrader already teaches the notification of one of the two parties who will ultimately

Art Unit: 3695

need to contact each other in order to negotiate. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1739 (2007). Further, the effect of the LIMITrader system is to ultimately put only one party in touch with only one counter party. Moreover, communication between counterparties at the inception of dealings would be a predictable way to further and promote the object of LIMITrader which is to "match that buy or sell interest with countervailing interest in the same security on the other side of the market, or (ii) enter into a negotiation process that may ultimately produce an executed trade." . "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one. If a person of ordinary skill in the art can implement a predictable variation, § 103 likely bars its patentability." Id. at 1740.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3695

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571)272-8594. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/
Primary Examiner, Art Unit 3696

Application/Control Number: 10/032,535
Art Unit: 3695

Page 26